

REMARKS

A request for continued examination under 37 CFR 1.114 was filed following the final rejection of the present application. As such, the Examiner has withdrawn the finality of the Office Action pursuant to 37 C.F.R. 1.114. With this non-final Office Action, mailed March 9, 2009, claims 1-40 are pending. It is asserted that, for the reasons described below, the claims are in condition for allowance and favorable action in this regard is respectfully requested.

Claims 1, 11, 24, and 29-40 are currently amended. No claims have been withdrawn or cancelled, and no new claims have been added.

Assignee's representatives Howard Skaist and Glenn Foster wish to extend our appreciation to Examiner Wassum for the interview of May 13, 2008. A summary of the interview has been prepared by Examiner Wassum and is publicly available.

Priority Claim

Assignee notes the Examiner's statement of paragraphs 4 and 5 of the Office Action regarding domestic priority under 35 USC § 119(e) for the benefit of priority to the prior filed application 60/397,542, filed July 22, 2002. The Office Action indicates that the provisional application is substantially more limited in its teaching than the instant application. The Examiner indicates that "at least claims 4-10, 12, 13, and 15-17 are not entitled to the priority date of the provisional application" because "at the least, the provisional application fails to disclose any aspect involving non-patent publications, association of times with data elements, and also fails to disclose any graphical display of the analysis results." Assignee currently takes no position on this issue since it is not related to the issues currently in prosecution. However, Assignee specifically does not acquiesce in the Examiner's view on this issue.

Assignee notes the Examiner's statement of paragraphs 6 and 7 of the Office Action regarding domestic priority under 35 USC § 120 as a continuation-in-part to the U.S. Patent Application 09/645,626, now U.S. Patent No. 6,604,114, which is a continuation of U.S. Patent Application

09/454,457, filed December 3, 1999, now abandoned, which claims priority of provisional U.S. Patent Application 60/111,111, filed December 4, 1998, and to provisional U.S. Patent Application 60/111,112, filed December 4, 1998. The Examiner indicates that parent application 09/645,626 does not fully support the independent claims of the instant disclosure concerning the limitation that any number of recursive searches may be performed in order to include one or more generations of interrelated data elements. Assignee notes the language has been amended instead to recite "second set being identified by at least two generations of search queries at least partially identified using the special purpose computer, in which any successive search query in comparison with the immediately preceding search query is capable of being contracted, expanded and/or otherwise modified to include one or more generations of interrelated data elements without any human intervention." Assuming, for the sake of legal argument, without conceding, that the recursive language does not find precise support; regardless, the current language does find support. For example, search queries are discussed in various places throughout the specification, including pages 16-19.

35 U.S.C. §101 Rejection

Claims 1-23 and 29-36 are rejected under 35 U.S.C. §101 because, the Examiner indicates, the claimed invention is directed to non-statutory subject matter. This rejection is respectfully traversed, in particular, because the US Supreme Court recently decided to hear the Bilski case.

However, in a recent appeal, the Federal Circuit in the Bilski case indicates a process claim satisfies the statutory subject matter requirement of 35 U.S.C. §101 if a) it is tied to a particular machine or apparatus; or b) the process transforms particular article into a different state or thing.

The language of claim 1, as amended, comprises the language "the second set being identified by at least two generations of search queries at least partially identified using the special purpose computer, in which any successive search query in comparison with the immediately preceding search query is capable of being contracted, expanded and/or otherwise modified to include one or more generations of interrelated data elements without any human intervention." Support for this language is provided at paragraph [0032] of the specification, as filed, for example.

As such, Assignee submits that claim 1 therefore covers statutory subject matter under 35 U.S.C. §101. Similarly, amended independent claims 11 and 24 contain similar limitations. It is therefore requested that the Examiner withdraw his rejection of claims 1-23 and 29-36 on this ground.

Claim Rejections Under 35 U.S.C. §112

The Examiner has rejected claims 1-40 under 35 U.S.C. §112, first paragraph. The rejection is respectfully traversed. "Independent claims 1, 11, and 24 have been amended to recite the limitation of performing any number of any number of generations of search queries, in which any successive search query in comparison with the immediately preceding search query is capable of being contracted, expanded and/or otherwise modified to include one or more generations of interrelated data elements without any human intervention. Support for this language is provided for example, at pages 16-19 of the specification, as previously indicated. It is therefore, requested that the Examiner withdraw this ground of rejection for claims 1-40.

Claim Rejections Under 35 USC §102

Claims 1-9, 11-16, and 18-40 were rejected under 35 USC §102(b) as being anticipated by U.S. Patent No. 6,339,767 to Rivette et al. (hereinafter Rivette et al.). This rejection of these claims on this ground is respectfully traversed. Assignee notes that claims 1, 11, 24, and 29-40 have been amended.

The Manual of Patent Examining Procedure ("MPEP"), in § 2131, states:

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. V. Union Oil Co. California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987).

Thus, under 35 USC § 102, a claim is anticipated *only if* each and every element of the claim is found in the cited document. It is respectfully submitted that this standard has not been met in this instance.

Claim 1 as amended specifically recites "the second set being identified by at least two generations of search queries at least partially identified using the special purpose computer, in

which any successive search query in comparison with the immediately preceding search query is capable of being contracted, expanded and/or otherwise modified to include one or more generations of interrelated data elements without any human intervention."

Thus, the language of claim 1 recites elements or limitations not shown in or taught by Rivette et al. This claim encompasses "second set being identified by at least two generations of search queries at least partially identified using the special purpose computer, in which any successive search query in comparison with the immediately preceding search query is capable of being contracted, expanded and/or otherwise modified to include one or more generations of interrelated data elements without any human intervention". Accordingly, it is asserted that regardless of how Rivette et al. is interpreted, it cannot be read to show or illustrate at least some of these features.

Accordingly, it is respectfully requested that the rejection of amended claim 1 under 35 USC §102(b) be withdrawn. Claims 11 and 24 are currently amended to contain similar limitations as claim 1, and thereby patentably distinguish on at least a similar basis. Likewise, claims 2-10 depend directly from claim 1; claims 12-23 depend from claim 11; and claims 25-40 depend either from claim 24. As such, claims 1-40 also patentably distinguish from Rivette on at least the same or similar basis. It is therefore respectfully requested that the Examiner withdraw the rejection of these claims.

35 USC §103 Rejection

Claims 10 and 17 were rejected under 35 USC §103 on Rivette et al. in view of Coleman, which further relate to a graphical display. This rejection of these claims on this ground is respectfully traversed.

The combined documents, whether considered individually or in combination, should teach or suggest all of the claim limitations of the rejected claims. However, as indicated above with respect to the response to the rejection under 35 U.S.C. §102, it was noted that Rivette et al. fails to disclose or show each and every element of the rejected claims. It is respectfully asserted that Coleman fails to cure the deficiency as noted above relative to Rivette et al. Therefore, without addressing whether or

not the combination of Rivette et al. in view of Coleman is proper, it is nonetheless asserted the combination would fail to provide all of the elements of the amended claims. Assignee therefore respectfully requests that the Examiner withdraw his rejection of these claims on this ground.

Failure of the Assignee to respond to a position taken by the Examiner is not an indication of acceptance of acquiescence of the Examiner's position. It is believed that the Examiner's positions are rendered moot by the foregoing and, therefore, it is believed not necessary to respond to every position taken by the Examiner with which Assignee does not agree. Instead, it is believed that the foregoing addresses the issues raised by the Examiner and that the present claims are in condition for allowance.

Conclusion

In light of the foregoing, reconsideration and allowance of the claims, as amended, is hereby earnestly requested. Assignee respectfully submits that pending claims 1-40, as amended, are in condition for allowance and a notification of such allowance is respectfully requested. If the Examiner believes that there are remaining informalities that can be corrected by an Examiner's amendment, a telephone call to the undersigned at 503-439-6500 is respectfully submitted. Any fees or extensions of time believed to be due in connection with this amendment are enclosed herein; however, consider this a request for any extension inadvertently omitted, and charge any additional fees to Deposit Account 50-3130.

Invitation for a Telephone Interview

The Examiner is invited to call the undersigned attorney, Howard Skaist, at (503) 439-6500 if there remains any issue with allowance.

Respectfully submitted,

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